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Reply to Office Action dated: November 23, 2005

REMARKS/ARGUMENTS

Claims 2, 5-15, 17-21 and 23-41 are pending in the present application. Claims 2, 5-15, 17-21 and 23-41 are rejected under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement. Claims 2, 5-15, 17-21 and 23-41 are rejected under 35 U.S.C §112, first paragraph, as failing to comply with the enablement requirement. Claims 2, 5-15, 17-21 and 23-41 are rejected under 35 U.S.C §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2, 5-15, 17-21, 23-41 are rejected under 35 U.S.C. §103 as being obvious over Krause (US Patent No. 5,526,520) in view of Wanatabe (US Patent No. 6,372,612 B1). Claims 2, 5-15, 17-21, 23-41 are rejected under 35 U.S.C. §103 as being obvious over Bobo, (US Patent No. 5,675,507) in view of Fabbio (US Patent No. 5,870,089). In this Amendment, claims 1-41 are hereby cancelled without prejudice or disclaimer. New claims 42-77 are added.

REJECTIONS UNDER 35 U.S.C. §112, first paragraph

With regard to the §112, first paragraph rejections, Applicants submit new claims 42-77 overcome any previous rejections.

REJECTIONS UNDER 35 U.S.C. §112, second paragraph

Former claims 2, 5 through 15, 17 through 21 and 23 through 41 stood rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

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(i.e., un-selected indicator or unspecified location is not disclosed in specification).

Applicant respectfully traverses any similar rejection with regard to new claims 42-77.

While the word "un-selected" may not literally appear in the specification, one

skilled in the art would recognize and know how to practice the claimed invention using

"un-selected indicator" upon reading the specification. As to definiteness, the

prosecution history clarifies the phrases to mean a location whose address is not specified

and an indicator that has not been selected by a user, respectively. As such, the phrases

are "fairly simple and intelligible, [and] capable of being understood in the context of the

patent specification. It is thus reasonably clear what the invention is and that the patent

specification conveys that meaning." All Dental Prodx, LLC et al. v. Advantage Dental

Products, Inc., 309 F.3d 774, 779 (Fed. Cir. 2002). As Judge Lourie stated in All Dental:

> The primary purpose of the definiteness requirement is to ensure that the
> claims are written in such a way that they give notice to the public of the extent of
> the legal protection afforded by the patent, so that interested members of the
> public, e.g., competitors of the patent owner, can determine whether or not they
> infringe. Warner-Jenkinson, 520 U.S. at 28-29. That determination requires a
> construction of the claims according to the familiar canons of claim construction.
> Only after a thorough attempt to understand the meaning of a claim has failed to
> resolve material ambiguities can one conclude that the claim is invalid for
> indefiniteness. **Foremost among the tools of claim construction is of course
> the claim language itself, but other portions of the intrinsic evidence are
> clearly relevant, including the** *patent specification and prosecution history.*
> See Standard Oil Co. v. Am. Cyanamid Co., 774 F.2d 448, 452, 227 USPQ 293,
> 296 (Fed. Cir. 1985) ("The specification is, thus, the primary basis for construing
> the claims. . . . [T]he prosecution history (or file wrapper) limits the interpretation
> of claims so as to exclude any interpretation that may have been disclaimed or
> disavowed during prosecution in order to obtain claim allowance."). **The**
> *prosecution history can thus be relied upon* **to clarify the claim meaning and
> hence provide definiteness.** Tex. Instruments Inc. v. Int'l Trade Comm'n, 871
> F.2d 1054, 1063, 10 USPQ2d 1257, 1263-64 (Fed. Cir. 1989) ("**The public is
> entitled to know the scope of the claims but** *must look to both* **the** *patent
> specification and the prosecution history,* **especially when there is doubt**

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> **concerning the scope of the claims.**" (citing <u>McGill Inc. v. John Zink Co.</u>, 736
> F.2d 666, 221 USPQ 944 (Fed. Cir. 1984))).

(Bolding and Italics added by Applicant.) (*See* <u>All Dental</u> 309 F.3d at 779-780)

Likewise, it is well settled case law that in order to meet the written description requirement, the specification "'need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed." *See* <u>All Dental</u> 309 F.3d at 779, (citing <u>Eiselstein v. Frank</u>, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (citing <u>Vas-Cath</u>, 935 F.2d at 1562, 19 USPQ2d at 1115, and <u>In re Wertheim</u>, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976))). In fact, "the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented." *See* <u>All Dental</u> 309 F.3d at 779, (citing <u>Eiselstein</u>, 52 F.3d at 1039, 34 USPQ2d at 1470. In the present application, the invention clearly involves a system and method for processing the contents of a primary document to locate an indicator that is merely present (*i.e.*, un-selected by a user) in the primary document, identifying a secondary document associated with the un-selected indicator, and encapsulating the secondary document within the primary document. Similarly, it is also clear that the invention does not involve a system and method for embedding indicators linked to specific files/locations that are only processed after they are selected by a user, as in the Krause and Bobo, II patents.

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Applicants submit that the claims in their present form overcome all 35 U.S.C.

§112, second paragraph issues and are allowable in their present form.

In addition, former claims 2, 5 through 15, 17 through 21 and 23 through 41 also

stood rejected under 35 U.S.C. ' 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as

the invention (*i.e.*, *attaching said secondary document to said primary document to*

encapsulate said secondary document within said primary document). Applicant

respectfully disagrees, traverses the rejection and submits that support for the relevant

limitations may be found at least at page 4, lines 13-14 of the specification.

Therefore, Applicants submit that the claims in their present form overcome all

35 U.S.C. §112, second paragraph issues and are allowable in their present form.

REJECTIONS UNDER 35 U.S.C. §103

A.   Krause-Watanabe

Former claims 2 through 9, 12 through 15, 17 through 21 and 23 through 41 stand

rejected under 35 U.S.C. §103 as being obvious over U.S. Patent No. 5,526, 520 to

Krause in view of U.S. Patent No. 6,372,612 to Watanabe. Applicant respectfully

disagrees and asserts that new claims 42-77 overcome any §103(a) rejection based on

Krause and Watanabe.

Applicants submit there is nothing in the Krause patent that discloses or suggests

"processing said primary document to locate an un-selected indicator; identifying said

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secondary document <u>associated with</u> said <u>located un-selected</u> indicator . . .," as recited in claim 42. Instead, the Krause patent operates only <u>after the selection</u> of a hotspot 55 (indicator) to identify the secondary document based on information in the <u>selected</u> hotspot (see column 4, lines 51 – 65). Similarly, there is nothing in the Watanabe patent that discloses or suggests the above-recited elements from claim 42 that are missing from the Krause patent. Therefore, Applicants submit there is no basis for combining the two cited references to support a proper §103 rejection of claim 42 in its present form, and it is respectfully requested claim 42 be allowed.

Therefore, for at least those reasons given above for claim 42, claims 56, 61, 65, 68 and 69, as well as those claims depending, respectively, therefrom, overcome any §103(a) rejection based on Watanabe in view of Krause as well. Accordingly, it is respectfully requested that these claims be allowed in their present form.

B.   <u>Bobo-Fabbio</u>

Former claims 2, 5 through 15, 17 through 21 and 23 through 30 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,675,507 to Bobo, II in view of U.S. Patent No. 5,870,089 to Fabbio. Applicant respectfully disagrees and asserts that new claims 42-77 overcome any §103(a) rejection based on Bobo and Fabbio.

Applicants submit there is nothing in the Bobo, II patent that discloses or suggests "processing said primary document <u>to locate</u> an <u>un-selected</u> indicator; identifying said secondary document <u>associated with</u> said <u>located un-selected</u> indicator . . .," as recited in claim 42. Instead, the Bobo, II patent discloses a Message and Storage Delivery System

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(MSDS) that receives and stores facsimile, voice and data messages and notifies the

recipient of the messages via a generated e-mail that a message has been received (see

Abstract). Specifically, the Bobo, II patent MSDS operates by receiving a message

(primary document) (step 50) for an intended recipient, storing the message (step 54) for

the intended recipient, notifying the intended recipient of the message (step 56),

converting the message to an HTML document (tertiary document) based on user

preferences (step 58), receiving a request from the intended recipient for information on

the stored message (step 76), generating a separate listing (secondary document) of the

received message and other messages either with or without embedded HTML images

(tertiary documents) of the message(s) (steps 102, 112, 120, 130 and 150), and moving

(sending) the file to the Internet Server (step 104). (*See* FIGs. 2, 3, 4A and 4B; column 7,

lines 3 – 12, 38 – 50; column 9, line 46 – column 10, line 26.) In other words, in the

Bobo, II patent, the secondary document is not "attach[ed] . . . to said primary document

to encapsulate said secondary document within said primary document," as recited in

claim 42. Similarly, there is nothing in the Fabbio patent that discloses or suggests the

above-recited element from claim 42 that is missing from the Bobo, II patent. Therefore,

Applicants submit there is no basis for combining the cited references to support a proper

§103 rejection of claim 42 in its present form, and it is respectfully requested claim 42 be

allowed.

Therefore, for at least those reasons given above for claim 42, claims 56, 61, 65,

68 and 69, as well as those claims depending, respectively, therefrom, overcome any

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§103(a) rejection based on Bobo in view of Fabbio as well. Accordingly, it is

respectfully requested that these claims be allowed in their present form.

Response to Arguments

In reply to the Examiner's statements in paragraph 4, page 3 of the outstanding

Office Action, the following comments are provided.

As shown in Applicant's response to the §112 rejection above, the specification

and subsequent prosecution history clearly do disclose the un-selected indicator.

Likewise, **there is nothing** in the specification that would indicate to the Examiner that

the un-selected indicator should be interpreted so broadly as to include the Examiner's ".

. . pointer, locator, URL, address, etc." In fact, the only definitions and examples of an

indicator provided in the specification can not be interpreted so broadly. For example,

In accordance with the present invention, the indicator may include several

different types of indicators. In a first exemplary embodiment, the indicator may be one

of several individual words or characters that typically indicate that a secondary

document should be attached. In a second exemplary embodiment, the indicator may be

one of a plurality of phrases that may typically indicate that a secondary document should

be included. In a third exemplary embodiment, the existence of an indicator may be

determined by using syntactic processing (otherwise known as natural language

processing). (Page 2, 5th full paragraph.) (Bolding and underscoring added by

Applicant.)

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In addition, the present invention may enable the user to add additional <u>terms or phrases</u> to the possible indicators to personalize the system or method for each specific user. Thus, the present invention may allow a user that employs <u>terminology or characters</u> that may not be commonly used. Furthermore, once the system or method according to the present invention determines that a secondary document should be attached, the system or method may also determine either a potential filename or location of the secondary document. (page 3, 1ˢᵗ paragraph.) (Underscoring added by Applicant.)

The plurality of indicators may include a <u>plurality of predetermined words that are typically used to indicate that a related document should be attached to primary document 50</u>. Some <u>examples of predetermined words include</u> **"attached," "enclosed," "included," and "attachment."** Those skilled in the art will understand that these are merely examples and that other words or characters may be included in the plurality of indicators without departing from the scope of the present invention. (Page 4, 1ˢᵗ full paragraph.) (Bolding and underscoring added by Applicant.)

In accordance with the present invention, indicator table 70 may also include <u>phrases or sets of words, instead of individual words or characters, that are typically used to indicate that a related document should be attached.</u> For example, some exemplary phrases may include **"I (or We) have attached," "I (or We) have enclosed," "I (or We) have included," "Please find enclosed," "Attached is the file,"** etc. Detecting phrases such as these instead of individual words or characters should result in a reduction of "false-positives" that would occur in the previous embodiments. False-positives occur when the processor detects a word or character included in indicator

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table 70, but instead of being an indication of a related document, the word or character

may merely be just another word in the document. For example, a sentence in primary

document 50 may read, "The wheel is attached to the axle of the car." The previous

embodiments would detect the word "attached" and determine that a related document

should be attached, which would probably not be the case. However, this third

embodiment would not determine that a related document should be attached since the

phrase "The wheel is attached" would probably not be included in indicator table 70.

(Page 6, 1st full paragraph.) (Bolding and underscoring added by Applicant.)

In a further exemplary embodiment of the present invention, the user may be

allowed to add additional entries to any of the tables (e.g., indicator table 70, subject table

72 and associations table 74). Thus, the user may further personalize the system by

adding slang terms, additional phrases, personalized references, nicknames or

associations to the respective tables in accordance with the present invention. (Page 9,

1st full paragraph.) (Underscoring added by Applicant.)

Any of the previous embodiments may be implemented to solve this CC list

problem using approaches similar to those discussed above with respect to attaching

secondary document 50. One modification may be to change the indicators which are

sought to be detected in primary document 50. Instead of words such as "attached," or

phrases such as "I have attached,"the indicators may include words or phrases indicating

that a person/entity should be on the CC list, such as the term "CC" or phrase "I have

CC'd." (Page 9, 4th full paragraph.) (Bolding and underscoring added by Applicant.)

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With regard to new claims 42-77, the subject matter of all of the former rejections

of claims 2, 5 through 15, 17 through 21 and 23 through 41 under 35 U.S.C. §103 are

believed to be overcome, and it is respectfully requested that the rejections be withdrawn

and a notice of allowance to that effect be issued. Therefore, the Examiner is respectfully

requested to withdraw his interpretation and conform it to the definitions clearly
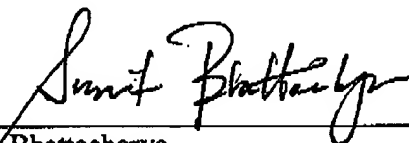
enumerated in the specification.

For at least the above reasons, Applicants respectfully submit that the present case

is in condition for allowance and respectfully requests that the Examiner issue a notice of

allowance.

The Office is hereby authorized to charge any fees determined to be necessary

under 37 C.F.R. §1.16 or §1.17 or credit any overpayment to Kenyon & Kenyon LLP

Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at (408) 975-7500 to discuss

any matter concerning this application.

Respectfully submitted,

KENYON & KENYON LLP

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